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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/250.667 05/27/94 NAKAMICHI

N M1653.8

EXAMINER  
DITMYER, P

E5M1/0824

ART UNIT PAPER NUMBER

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2512

DATE MAILED: 08/24/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.                  |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-26 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-26 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 07/572,050; filed on 8/23/90.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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**Assent of Assignee**

1. This application lacks full compliance with 37 C.F.R. § 3.73(b). See MPEP § 324. Although the assignee has filed an "assent of assignee," the language of Sec. 3.73 does not appear therein. Applications filed after 9/92 are required to contain a statement specifying that evidentiary documents (relating to the assignment) have been reviewed and certifying that, to the best of the assignee's knowledge and belief, title is in the assignee seeking to take action.

**Reissue Declaration**

2. The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

**Every** departure from the original patent represents an "error" in said original patent under 35 U.S.C. 251 and must be particularly and distinctly specified and supported in the reissue oath or declaration under 37 CFR 1.175.

Applicants newly presented claims 10-26 are replete with changes which are not particularly and distinctly specified and supported in the reissue oath or declaration.

MPEP 1414.02  
1400-C

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For example:

a. Claims 10-26, line 1 "A device for storing and playing disks";

b. Claims 10-19, line 3 "a disk reader accepting disks situated at a read position";

c. Claims 10-19, line 4 "storage means for storing a plurality of said disks";

d. Claims 10 and 12-19, line 5 "said storage means being nondetachably carried in said chassis";

e. Claims 10 and 16-19, lines 6-7 and claim 11, lines 5-6 "said storage means including a plurality of storage positions, each for accepting a single one of said disks";

f. Claims 12-15, lines 6-7 "said storage means including a plurality of concentric storage positions, each for accepting a single one of said disks"; and

g. Claim 10, line 7 and claim 11, line 6 "arranged in a concentric stack".

**Note:** The list above is not exhaustive as the newly presented claims 10-26 contain changes which are not particularly and distinctly specified and supported in the reissue oath or declaration and are too numerous to mention specifically.

3. The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the

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errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

The declaration states (pages 2-3):

These errors arose due to communication difficulties between the prosecuting attorneys and the applicant because of language differences, their respective languages being English and Japanese, in that the breadth of the invention was not completely appreciated before the patent issued. Subsequent to the issuance of the patent, the applicants further studied the issued patent and discovered that the English language claims included limitations upon their invention that were not required by law for the claims in question to be valid in view of the prior art.

However, this statement fails to **particularly specify** how the errors relied upon arose or occurred. 37 C.F.R. § 1.175(a)(5) requires a detailed factual explanation of the circumstances surrounding the occurrence of the error including dates, and when and how it was discovered. **The facts**, not merely conclusions, presented under (a)(5), will enable the examiner, and in turn the PTO, to independently conclude that the error was made without deceptive intent.

4. The reissue declaration filed with this application is objected to because of the following informalities: On page 5, line 6 it appears that "it requires" should be changed to -it does not require-. Appropriate correction is required.

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### **Claim Objections**

5. Claims 24 and 25 are objected to because of the following informalities: In claim 24, line 9 "said said" should be changed to -said-; in claim 25, line 11 "assess" should be changed to -access-. Appropriate correction is required.

6. Claims 25 and 26 are objected to under 37 CFR 1.121(e) as a new claim in a reissue application should be presented with underlining throughout the claim.

In claim 25, lines 5, 8-9 and 11-12 and claim 26, lines 10, 12-14 and 16-17 are not underlined.

### **Subsequent Amendments**

7. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(e).

### **Claim Rejections - 35 USC § 251**

8. Claims 1-26 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

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**Claim Rejections - 35 USC § 112**

9. Claims 2, 10-18 and 20-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 2, lines 21-22 "said magazine including means for receiving a plurality of said subframes" is vague and indefinite because it is unclear how the magazine has "means for receiving a plurality of...disks" (lines 4-5), the subframes include "means for receiving a single one of said disks" (lines 19-20) and the magazine includes "means for receiving a plurality of said subframes."

b. In claim 10, line 11, claim 11, line 10, claim 12, line 11, claim 13, line 11 and claim 14, line 11 "a surface of said disks" is vague and indefinite because it is unclear what "surface" of a concentric stack of disks is being referred to.

c. In claim 11, lines 14-15 "a direction of alignment of said storage means" is vague and indefinite because it is unclear what the storage means is aligned with.

d. In claim 15, line 8 "a chassis" is vague and indefinite because it is unclear whether this is the same chassis referred to in line 2 or another chassis.

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e. In claims 16-18, line 9 "said selectable one of said storage positions" lacks proper antecedent basis in the claims.

f. In claims 20, 22 and 23, lines 4-5, claim 21, lines 3-4 and claim 24, lines 5-6 "having a plurality of means for holding disks in a concentric array" is vague and indefinite because it is unclear how the magazine has more than one "means" for holding disks in a concentric array as there is only one concentric array of disks disclosed.

g. In claims 20 and 21, line 9 and claim 22, lines 10-11 "said mainframe at said first position" is vague and indefinite because it is unclear how the mainframe is at the first position which has been recited to be a position where disks are read.

h. In claim 20, line 17, claim 21, line 19, claims 22-24, line 18, claim 25, lines 10-11 and claim 26, lines 15-16 "loading and unloading of said magazine" is vague and indefinite because it is unclear whether the magazine is being loaded into the device or whether disks are being loaded into the magazine.

i. In claim 21, lines 16-17 "means for displacing said selected disk from said first position to a reader engaged position at said disk reader for reading" is vague and indefinite because it is unclear how the disks are read "at a first position" (line 5) and at "a reader engaged position at said disk reader."

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j. In claims 22 and 23, line 6 "a turntable for reading disks" is misdescriptive because the "turntable" does not read the disks.

**Claim Rejections - 35 USC § 102**

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 4, 8-19 and 24 are rejected under 35 U.S.C.

§ 102(b) as being clearly anticipated by Kawakami (US 4,567,584).

**Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

13. Claims 23 and 25 are rejected under 35 U.S.C. § 103 as being unpatentable over Kawakami in view of Imai et al (US 4,797,865).

Kawakami shows a chassis 11, a magazine 100, a disk reader 580, first disk transport means 300, second disk transport means 400, aligning means 150, displacing means 518, 519, and control means 900, 910. Kawakami does not show subframes/trays for carrying the disks.

However, Imai et al shows a device for storing and playing disks including a magazine 17 having a plurality of subframes 30 for carrying disks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the disk device of Kawakami with subframes for carrying the disks as shown by Imai et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to protect each disk in the device from damage in order to ensure a more reliable playback and transport of each disk.

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### Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

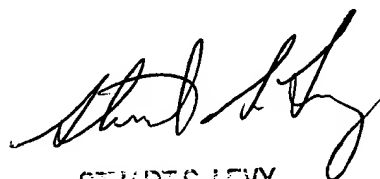
US 4,695,990 and US 5,103,437, both to Kawakami, are cited to show disk devices for playing and storing disks and including transport means.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Ditmyer whose telephone number is (703) 308-1611.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Paul J. Ditmyer  
Art Unit 2512  
August 17, 1995



STUART S. LEVY  
SUPERVISORY PATENT EXAMINER  
GROUP 2500